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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			D'AGOSTA, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/720,029	Applicant(s) DEEDS, DOUGLAS	
	Examiner Stephen M. D'Agosta	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-14, 17-24, 26-32, 34-35, 38-39, 42 and 44-45 is/are rejected.
- 7) ☒ Claim(s) 15,16,25,33,36,37,40,41,43 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

1. Since the applicant concedes that their patent US 7,0204,97 does not effectively combine ring tones/tunes, the examiner will remove the double patent rejection.

2. The drawing change to figure 1 is accepted. The objection to figure 1 is removed based on the applicant's answer.

3. Regarding the USC 112 rejection, the examiner notes that while the applicant is correct regarding how the examiner can/should interpret the meaning of a term presented, they do not specifically rule out the examiner's interpretation that the if/when the ring tune/tone is viewed as just a data file (and not a musical file), the prior art put forth reads on the claims. Hence the examiner will remove USC 112 rejection but notes that the claims are not novel over the prior art of record (since said claims are given their broadest reasonable interpretation).

4. The primary argument(s) put forth by the applicant focuses on Speeney's data combining with Lin's ring tone (eg. data file) and Speeney not teaching a ring tone (eg. the applicant argues Speeney teaches an announcement). The examiner disagrees since the claims must be given their broadest reasonable interpretation and Speeney teaches his data file being appended to (eg. played out) before the phone is answered (see C2, L27-37). The examiner notes that while Speeney does not provide an exact implementation of this function, it nonetheless reads on the typical ring tone (eg. file) being combined with a second file (eg. recorded message) such that the two play out to alert the user of an incoming call.

This is the primary reason the examiner put forth a USC 112 rejection (and even provided an example as to how the applicant could overcome the rejection, eg. by stating the two files are musical files and not an announcement file as described by Speeney). *Secondly, the specification does not limit what a "ring tune" can be, eg. who's to say that a radio personality may have a "song" whereby they speak/talk and that passage becomes famous and is a "ring tune" download favorite? (Rap music is typically spoken and not sung). Speeney's announcement would read on this particular example (eg. inserting a rap passage inside a melodic song).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11-12, 17-19, 21-23, 26-29, 31, 34-35, 38-39, 42 and 44-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. US 6,366,791 and further in view of Speeney et al. US 6,570,983.

As per **claims 1, 19, 22 and 26**, Lin teaches a method for providing a ring-tune alert in a communication device operable to receive communications via a communication network (title, abstract and figures 1-2 show music #55 being sent), said method comprising:

- detecting an incoming communication;
- determining at least one communication characteristic of the incoming communication;
- associating a first ring-tune enhancement with the at least one communication characteristic; and
- generating a composite ring-tune alert (C5, L3-19 teaches detecting an incoming call and the caller's ID wherein said caller's ID is associated with a ring tone/tune and it is played to distinguish that caller from another caller, eg. caller X and caller Y will cause the phone to ring differently) **but is silent on appending** the first ring tune enhancement to a base ring tune.

Speeney teaches appending an audible announcement of the caller's identity to the base ring tone (eg. the phone rings and then the identity is announced) (abstract and C2, L25-46), which reads on an enhancement to the first ring tone since they are both played to alert the user. The term "ring tune" can be broadly interpreted to be a spoken passage of a song whereby Lin's melodic ring tune would be combined with a spoken passage, similar to Speeney's invention. Rap music is typically spoken and not

sung and could be appended to Lin's ring tune. Therefore Rap music would be considered both a ring tune and spoken passage, which reads on the claim.

With further regard to claim 19, Lin teaches a processor in either the phone or network which performs the identification of the incoming caller and selects the appropriate ring tone.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that applying the first ring tune enhancement to a base ring tune, to provide means for varying the ring tune based on the caller's identity.

As per **claims 2-3**, the combination teaches claim 1 **but is silent on** further comprising the step of annunciating the enhanced ring tune and it is audible.

Lin does teach that the ring tune is played audibly (C5, L3-19 teaches the music tune is played).

Speeney teaches audibly announcing the caller's ID (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that it annunciates the enhanced ring tune and it is audible, to provide means for the user to hear the caller's identity.

As per **claim 4**, the combination teaches claim 1, further comprising the step of initializing a ring-tune database by storing the first ring-tune enhancement and the base ring tune (C3, L30-57 teaches the multiple ring tunes have been downloaded and figure 5 #65a/b shows tune stored in phone -- hence a caller's number that is **not** recognized will receive one (default) ring tune while any caller whose number is matched will receive their distinctive ring tune).

As per **claim 5**, the combination teaches claim 4, wherein the initializing step comprises downloading ring-tune information from an Internet-based server (figure 2 shows a web server #40 downloading music tunes to the phone, C3, L30 thru C4, L29).

As per **claims 6 and 29**, the combination teaches claim 1/26 **but is silent on** wherein the first ring-tune enhancement comprises appending a secondary ring-tune to the base ring tune.

Speeney teaches appending secondary file to the base ring tune to identify the caller (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the first ring-tune enhancement comprises appending a secondary ring-tune to the base ring tune, to provide means for the user to hear both the typical ringing tune/alert along with an added enhancement (eg. the caller's identity).

As per **claim 7**, the combination teaches claim 6, **but is silent** wherein the secondary ring-tune is a preamble appended in front of the base ring tune.

Speeney teaches appending secondary file to the base ring tune to identify the caller (C2, L25-46). One skilled would be able to position the secondary attachment to either the front or back of the base ring tune.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the secondary ring tone is appended to front/back, to provide means for the user to either hear first (or second) the caller's identity.

As per **claims 8 and 31**, the combination teaches claim 1/26, **but is silent on** wherein the first ring-tune enhancement comprises the addition of at least one accompaniment part to the base ring tune.

Speeney teaches appending secondary file to the base ring tune to identify the caller (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the first ring-tune enhancement comprises the addition of at least one accompaniment part to the base ring tune, to provide means for adding a caller's identity to the base ring tone.

As per **claim 11**, the combination teaches claim 1, wherein the base ring tone is one of a plurality of base ring tones selectable for application (C3, L30 thru C4, L29 teaches downloading ring tones which can be used as either base tones or distinctive tones, as selectable by the user).

As per **claim 12**, the combination teaches claim 11, wherein the selection of a base ring tune from the plurality of base ring tones is a function of the at least one communication characteristic of the incoming communication (C5, L3-20 teaches the caller's ID being used to determine which ring tune to use, eg. caller ID is a communication characteristic of the incoming call).

As per **claims 17 and 27**, the combination teaches claim 1/26, wherein the communication device is a mobile station operable within a wireless communication network (see figures 1-2).

As per **claims 18 and 28**, the combination teaches claim 1/26, wherein the communication device is a computer operable to receive communications via a connection to the Internet (see figure 2, shows web server, mobile unit and user computer).

As per **claim 21**, the combination teaches claim 19, **but is silent on** wherein the least one ring tune enhancement stored in the ring-tune database comprises a plurality of ring-tune enhancements for associating with communication characteristics.

Speeney teaches appending multiple audible announcements which are selected from a database (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that at least one ring tune enhancement stored in the ring-tune database comprises a plurality of ring-tune enhancements for associating with communication characteristics, to provide means for using a database to cross reference the ring tunes to a specific person/caller.

As per **claim 23**, the combination teaches claim 22, wherein the ring-tone generator is resident in the at least one mobile station and wherein the ring tune controller is not located in the mobile station, and further comprising means for the ring-tune controller to direct the ring-tune generator, via wireless communication, to generate the enhanced ring tone (C3, L12-20 teaches downloading whereas C4, L39-55 teaches storing the ring tune in the network).

As per **claims 34 and 38 and 44**, the combo teaches claim 1/19, but is silent on wherein the base ring tune comprises a plurality of base ring tunes, and wherein the first ring tune is only appended to a first base ring tune among the plurality of base ring tunes which are periodically rung.

The examiner takes Official Notice that the appending of a first ring tune can either be appended to one ring tune and/or to multiple ring tunes depending upon the configuration (eg. this is a design choice whereby the user may store multiple base ring tunes and therefore would be able to append to one, some or all of the base tunes).

It would have been obvious to one skilled in the art at the time of the invention to modify the combon, such that the base ring tune comprises a plurality of base ring tunes, and wherein the first ring tune is only appended to a first base ring tune among the plurality of base ring tunes which are periodically rung, to provide means for appending the first ring tune in between the space created by dividing the base tune.

As per **claims 35, 39 and 42 and 45**, the combo teaches claim 1/19, wherein the composite ring-tune comprises inserting the first ring tune into the base ring tune, the base ring tune being divided into a plurality of pieces (Lin's ring tune would be transmitted and stored in memory as either one file and/or multiple files depending upon the capability of the phone's storage. The base ring tune would inherently be divided into pieces whereby the first/new ring tune would be appended into the space between pieces).

Claims 9, 20 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin/Speeney and further in view of Schmidt et al. US 6,363,258.

As per **claims 9 and 30**, the combination teaches claim 1/26, **but is silent on** wherein the first ring-tune enhancement comprises application of a tonal adjustment to the base ring tune.

Schmidt teaches changing the tone (eg. volume) of the call based on the calling party who is calling:

"..While the response of the Enhanced Terminal type mobile terminals 20 has been described in terms of whether to auto-answer the group call or not, other responses are also possible. For instance, based on the information provided by the indicator flags, the mobile terminals 20 of the present invention may vary information displayed on their displays 28 or change their alert signals (e.g., ring tone, ring volume, vibrations generated, etc.) depending on the characteristics of the incoming group call. Just by way of example, the mobile terminal may loudly ring with a particular tone when a group call with alert priority is detected, and "Alert" may be indicated on the display 28, while group calls of Sequential subtype with normal priority may only result in a low level vibration and a display of the caller ID. Of course, these responses of the mobile terminal 20 may be pre-set at the factory or may be user selectable to provide maximum flexibility.."

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the first ring-tune enhancement comprises application of a tonal adjustment to the base ring tune, to provide means for changing the ring tone in several different manners for different situations.

As per **claim 20**, the combination teaches claim 19, **but is silent on** wherein the mobile station comprises a vibration generator, and wherein the first ring-tune enhancement comprises the addition of a vibrating effect to the base ring-tune.

Schmidt teaches modifying the ring (eg. ring with vibration) based on the calling party (C10, L34-50).

"..While the response of the Enhanced Terminal type mobile terminals 20 has been described in terms of whether to auto-answer the group call or not, other responses are also possible.

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For instance, based on the information provided by the indicator flags, the mobile terminals 20 of the present invention may vary information displayed on their displays 28 or change their alert signals (e.g., ring tone, ring volume, **vibrations generated**, etc.) depending on the characteristics of the incoming group call. Just by way of example, the mobile terminal may loudly ring with a particular tone when a group call with alert priority is detected, and "Alert" may be indicated on the display 28, while group calls of Sequential subtype with normal priority may only result in a low level vibration and a display of the caller ID. Of course, these responses of the mobile terminal 20 may be pre-set at the factory or may be user selectable to provide maximum flexibility.."

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that it uses a vibration generator, and wherein the first ring-tune enhancement comprises the addition of a vibrating effect to the base ring-tune, to provide multiple different ways in which to alert the mobile user to the call.

Claims 10, 24 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin/Speeney and further in view of Narinen et al. US 2002/0115456.

As per **claims 10 and 32**, the combination teaches claim 1/32, **but is silent on** wherein the first ring-tune enhancement comprises application of a stylistic adjustment to the base ring tune.

Narinen teaches modifying ring tones on a phone whereby changes to the tone include style changes (see abstract and Paragraph #6).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that wherein the first ring-tune enhancement comprises application of a stylistic adjustment to the base ring tune, to provide means for changing the ring tone in several different manners for different situations.

As per **claim 24**, the combination teaches claim 22, **but is silent on** wherein the at least one enhancement is a tempo enhancement.

Narinen teaches modifying ring tones on a phone whereby changes to the tone include tempo changes (see abstract and Paragraph #6).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the at least one enhancement is a tempo enhancement, to provide multiple ways in which to modify the base ring tune to alert the user to a call.

Claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin/Speeney and further in view of Moss et al. US 2002/0176554.

As per **claim 13**, the combination teaches claim 1, **but is silent on** wherein this step of determining at least one communication characteristic comprises the step of transmitting a request for communication-characteristic information AND the step of receiving a response to the request for communication-characteristic information.

Moss teaches requesting caller ID data and providing it to the phone:

[Para 0013] FIG. 1 is a block diagram of a telephone system 20 capable of implementing the invention in accordance with one embodiment of the invention. A destination service switching point (SSP) 22 has a plurality of destination numbers 24. The destination SSP 22 is connected to a switching control point (SCP) 26 by a signaling system seven (SS7) link 28. The SCP 26 has a caller ID with name database 30 and a custom caller ID with name database 32. Standard caller ID with name service results in a trigger when a call is placed to a telephone number 24 subscribing to the service. The SSP 22 sends a query to the SCP 26 requesting caller ID information. The SCP 26 does a lookup on the caller ID with name database 30 and passes the caller's name, telephone number, date and time to the customer's telephone. Unfortunately, as explained above, the customer only receives an organization's name when the call is placed from an organization. Part of the reason for this is that large organizations lease a group of telephone numbers and hand these out to employees. As a result, the service provider does not have the name information. In addition, organizations have a tendency to move employees to new telephone numbers regularly.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that determining at least one communication characteristic comprises the step of transmitting a request for communication-characteristic information AND the step of receiving a response to the request for communication-characteristic information, to provide means for the phone to receive caller ID info so that it can be used to select a ring tune based on said caller ID.

Allowable Subject Matter

Claims 15-16, 25, 33 and 36-37, 40-41, 43 and 46 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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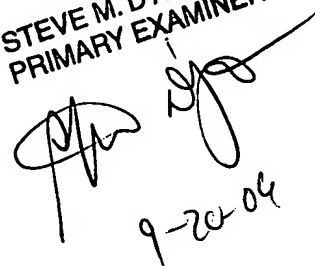
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEVE M. D'AGOSTA
PRIMARY EXAMINER



9-20-04